

III. REMARKS/ARGUMENTS

A. Generally

Applicant has withdrawn claims 21 -24 as being drawn to a non-elected invention.

The Examiner has indicated that claims 1 - 24 are pending in the application; that claims 21 - 24 are withdrawn; that claims 1, 3, 5, 7, 11, 13 15, and 17 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention; that claims 1, 3, 5, 7, 11, 13, 15, and 17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention; that claims 1 - 20 are rejected under 35 U.S.C. 103(a) as unpatentable over Inamiya. Applicant, by this Amendment, withdraws claims 21 - 24, and submits argument in support of allowability of all pending claims.

B. Response to Rejections Based on 35 U.S.C. § 112

The Examiner has indicated that claims 1, 3, 5, 7, 11, 13, 15 and 17 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention. Specifically, the Examiner has indicated that the rejected claims are not supported by the specification, since they lack a teaching of how such limitations were determined. The Examiner has also indicated that these same claims (1, 3, 5, 7, 11, 13, 15 and 17) are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Here, the Examiner has suggested that the rejected claims are indefinite since it is not clear how the limitations were determined.

Applicant respectfully disagrees. The specification states “In the preferred embodiment, the composition includes any proportion greater than 50% hemp fiber, e.g., approximately 80% hemp pulp, and 20% other material ...”. The specification goes on to state “The resultant speaker cones have been found to have superior tone and sonic properties (e.g., no distortion or ghost notes) and increased durability (e.g., increased power handling capability) when compared to other known speaker cone constructions”, and provides numerous examples of various compositions in the detailed description, with proportions corresponding to the limitations cited in the claims.

Thus, the specification clearly supports the claim limitations, and gives examples of how they were determined and implemented. A disclosure provides adequate written description if it conveys with reasonable clarity to those skilled in the art that the inventor was in possession of the invention. *Purdue Pharma L.P. v. Faulding Inc.*, 230 F. 3d 1320, 1323 (Fed Cir. 2000).

C. Response to Rejections Based on 35 U.S.C. § 103(a)

The Examiner has indicated that claims 1 - 20 are rejected under 35 U.S.C. 103(a) as unpatentable over Inamiya.

Section 103(a) provides that “A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.” 35 U.S.C. §103(a).

A long line of cases stand for the proposition that when the patented invention is made by combining known components to achieve a new system, the prior art must provide a suggestion or motivation to make such a combination. *Heidelberger Druckmaschinen v.*

Hantscho Commercial Prods., Inc., 21 F.3d 1068, 30 U.S.P.Q.2d 1377, 1379 (C.A.F.C.1994); *Northern Telecom, Inc. v. Datapoint Corp.*, 908 F.2d 931, 934, 15 U.S.P.Q.2d 1321, 1323 (C.A.F.C.), cert. denied, 498 U.S. 920 (1990); *In re Geiger*, 815 F.2d 686, 688, 2 U.S.P.Q.2d 1276, 127 (C.A.F.C.1987). The mere fact that the prior art *may* be modified in the manner suggested by the examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. *In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780, 1783-84 (C.A.F.C. 1992); *In re Gordon*, 733 F.2d 900, 902, 221 U.S.P.Q. 1125, 1127 (C.A.F.C. 1984). The question is not whether what is claimed *could* have been done, but rather whether it was *obvious* to do so in light of all the relevant factors. *Arkie Lures Inc. v. Gene Larew Tackle Inc.*, 119 F.3d 953, 957, 43 U.S.P.Q.2d 1294, 1297 (C.A.F.C.1997).

In order for the knowledge of persons of ordinary skill in the art to be sufficient to impart the motivation to combine references, the rejection must explain what specific understanding or technological principle within the knowledge of one of ordinary skill in the art would have suggested the combination of references. *Id.* Lacking a motivation to combine references, a proper *prima facie* case of obviousness is not shown. *Id.* A lofty level of skill alone does not suffice to supply a motivation to combine separate prior art disclosures. *In re Rouffet*, 149 F.3d 1350, 1359, 47 U.S.P.Q.2d 1453, 1459 (C.A.F.C. 1998).

A statement that modifications of the prior art to meet the claimed invention would have been " 'well within the ordinary skill of the art at the time the claimed invention was made' " because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references. *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993). See also *In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1318 (Fed. Cir. 2000) (Court reversed obviousness rejection involving technologically simple concept because there was no finding as to the principle or specific

understanding within the knowledge of a skilled artisan that would have motivated the skilled artisan to make the claimed invention); *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999) (The level of skill in the art cannot be relied upon to provide the suggestion to combine references.). [See MPEP § 2143.01]

To support the conclusion that a claimed combination is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed combination or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references. *Ex parte Clapp*, 227 U.S.P.Q. 972, 973 (P.T.O. Bd. Pat. App. & Int. 1985).

In the instant case, it is respectfully submitted that there is no suggestion or teaching in the cited reference, alone or in combination with known prior art or knowledge of those skilled in the art, to include the claimed invention.

Specifically, Inamiya discloses a speaker cone with silk as the principal material (see Inamiya specification column 3, lines 48 - 61), with other ingredients such as hemp or other bast fiber to provide mechanical strength. However, Inamiya even discusses no hemp: the Inamiya disclosure specifically provides for a proportion of hemp to be up to approximately 30%, but states that “other types of bast fibers may be substituted therefor without departing from the spirit and scope of the invention.” (Inamiya column 3, lines 22 - 24). Thus, Inamiya discloses a “silk-based” speaker composition, with hemp as only one of many possible minor constituents, or no hemp at all. Inamiya certainly does not disclose or suggest that a speaker cone could be constructed primarily of hemp (i.e., at least 50%), as is required by applicant’s claims.

IV. CONCLUSION

In view of these amendments and comments it is believed that each of the presently pending claims in this application is in condition for immediate allowance, and such allowance is

therefore respectfully requested. The Examiner is invited to call Applicant's undersigned attorney if, in the opinion of the Examiner, a telephone conference will in any way expedite prosecution of this application.

Respectfully Submitted,

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